



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAIL

Paper No. 14

Rosenthal & Osha L.L.P.
1221 McKinney Avenue
Suite 2800
Houston, TX 77010

OCT - 9 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of: Huang et al.)
Application No. 09/635,116)
Attorney Docket No. 05516/056002) DECISION ON THIRD-PARTY
Filed: August 9, 2000) PETITION TO WITHDRAW
For: METHOD FOR SIMULATING) APPLICATION FROM ISSUE UNDER
DRILLING OF ROLLER CONE BITS AND) 37 CFR § 1.313
ITS APPLICATION TO ROLLER CONE)
BIT DESIGN AND PERFORMANCE)

This is a decision on the third-party petition filed April 15, 2003 to withdraw the application from issue under 37 CFR § 1.313. The petition was accompanied by a protest under 37 CFR § 1.291 and authorization to charge petitioner's deposit account.

The petition is **DENIED**.

The third-party protest under 37 CFR § 1.291 has NOT been placed in the above identified application because it was submitted after the mailing of the notice of allowance. Because the protester indicated the applicants have been served with a copy, the original protest has been discarded. See MPEP 1901.06. However, the protest under 37 CFR § 1.291 is directed to "any application claiming the benefit of the filing date of application serial No. 09/635,116." This citation is considered a sufficient identification of the pending application(s) to which the protest is directed under the guidelines set forth in 37 CFR § 1.291(a) and a copy of this protest is therefore being forwarded to the appropriate application(s).

BACKGROUND

On April 15, 2003, petitioner, acting on behalf of a third party, filed a petition requesting, *inter alia*, withdrawal of the above-noted application ('116) from issue and that the application be returned to the examiner for the purpose of considering a request for an interference by petitioner. The petitioner has copied claims of 09/635,116 into pending application 09/833,016 for the purpose of requesting an interference with application '116.

ISSUES

The petitioner requests extraordinary relief because the above noted application issuing before an interference is declared will permit the assignee of application '116 to assert that patent against the petitioner's assignee. Petitioner requests the Office take action *sua sponte* should the petition fail due to a lack of standing.

DECISION

The petitioner lacks standing to request the relief specified in the petition.

37 CFR § 1.313 states:

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary. A petition under this section is not required if a request for continued examination under § 1.114 is filed prior to payment of the issue fee. If the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application.

(b) Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except:

- (1) A mistake on the part of the Office;
- (2) A violation of § 1.56 or illegality in the application;
- (3) Unpatentability of one or more claims; or
- (4) For interference.

(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:

(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;

(2) Consideration of a request for continued examination in compliance with § 1.114; or

(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

(d) A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. Withdrawal of an application from issue after payment of the issue fee may not be effective to avoid publication of application information.

The express language of the rule is directed only to the Office and to the applicant. No provision is made in either the rules or the Manual for Patent Examining Procedure for such a request by a third party. Therefore, petitioner has not shown, nor is it apparent, that petitioner may invoke, or request to invoke, this regulation.

In regards to the petitioner's request that the Office take such action *sua sponte*, the Director may withdraw an application from issue. See *Harley v. Lehman*, 981 F. Supp. 9, 12, 44 USPQ2d 1699, 1702 (D.D.C. 1997). However, 35 USC § 151 provides that upon payment of the issue fee, "the patent shall issue." If a determination were made that at least one of the conditions specified at 37 CFR § 1.313(b)(1) through (4) existed such that an applicant was no longer "entitled to a patent under the law" then the Director would be authorized to withdraw the application from issue after payment of the issue fee. See MPEP 1308. The USPTO is authorized to withdraw an application from issue after the payment of the issue fee for

interference. See 37 CFR § 1.313(b)(4). Interference is defined as “a proceeding instituted in the Patent and Trademark Office before the Board to determine any question of patentability and priority of invention between two or more parties claiming the same patentable invention.” See 37 CFR § 1.601(i). As no interference has been declared to date, the conditions of 37 CFR § 1.313(b) have not been met and the patent shall issue.

Accordingly, the petition is **DENIED**.

Telephone inquiries should be directed to Josie A. Ballato, Special Programs Examiner, at (703) 308-0269.

Peter Wong
Group Director
Technology Center 2100
Computer Architecture, Software, and Information Security

Cc: Charles L. Gholz
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
Fourth Floor
1940 Duke Street
Alexandria, VA 22314